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REMARKS

Claims 1-53 remain pending in the present application. By the present amendment, claims 34 and 44-53 have been amended and new claim 54 has been added.

The present application includes four independent claims - 1, 29, 34, and 44. Claims 1-28 have been allowed. Claims 29-33 have been rejected under 35 U.S.C. §§102(b) and 103(a) in view of Park et al. Claims 34-53 have been rejected under 35 U.S.C. §§102(b) and 103(a) in view of Cleveland et al. The status of claims 42 and 52 is unclear as they have both been rejected in view of Cleveland et al. and objected to as including allowable subject matter. Minor objections have also been made to the form of the claims.

Claim 29 recites, among other things, that the sample stage is "suspended" from the microscope coupling. Similarly, new claim 54 recites that the sample stage is suspended "from below said microscope coupling while engaged with said coupling." In contrast the cited reference, Park et al. (US 6,265,718), teaches a conventional sample stage that includes an x, y coarse stage for positioning the sample horizontally at the proper position below the cantilever. The sample stage of the Park et al. reference is not suspended from a microscope coupling or engaged with a coupling while suspended. Accordingly, applicants respectfully assert that the Park et al. reference does not anticipate the subject matter of claim 29.

Claims 34 and 44, as amended, recite that the cantilever unit is secured to the solenoid unit. Claims 35-43 and 45-53, which claims include more specific recitations related to the manner in which the cantilever is secured to the solenoid unit were rejected under 35 U.S.C. §103(a) as being obvious in view of Cleveland et al. However, it is important to note that the prior art references must teach or suggest all the claim limitations to establish a *prima facie* case of obviousness. See MPEP 2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In the present context, applicants respectfully assert that the sole reference cited in support of the obviousness rejection, Cleveland et al., includes no teachings or suggestions that the cantilever can or should be secured to the solenoid unit. In fact, the illustrations of the reference arguably teach

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away from the claimed recitations in that they clearly show the cantilever and solenoid unit in a non-contacting, disengaged relationship.

Applicants acknowledge that the Office Action states that "it would have been obvious to ... modify the teachings of Cleveland et al. for the purpose of applying a magnetic field to the probe." However, the Office Action fails to cite any reference that actually teaches securement of the cantilever to the solenoid unit of a scanning probe microscope. The only reference cited actually teaches away from the claimed recitations. Accordingly, applicants respectfully assert that the cited reference does not support a proper *prima facie* case of obviousness with regard to claims 34 and 44, as amended, and claims 35-43 and 45-53.

All of the objections to form raised in the Office Action are addressed in the above amendment to the claims.

Accordingly, applicants respectfully submit that, in view of the above amendments and remarks, the application is now in condition for allowance. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, early notification of allowable subject matter is respectfully solicited.

Respectfully submitted,

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